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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,937	09/15/2003	Kenneth Brazell	OWT 0195 PUS / PTG 1097 P	2020
757	7590	03/16/2007	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			MAPLES, JOHN S	
			ART UNIT	PAPER NUMBER
			1745	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/16/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/662,937	BRAZELL ET AL.	
	Examiner	Art Unit	
	John S. Maples	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 27 July 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16, 18-29 and 32-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16, 18-29, 32-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

1. This office action is being re-mailed and the shortened statutory period is being re-started because the original office action was mailed to an incorrect address..

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-16, 18-29, 32-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. (New Rejection)

The expression "fixedly attached" found in claims 1 and 26 do not find support in the present specification. It is not clear exactly what is meant by this terminology.

Claims 2-15, 18-25, 31, 32, 36, 37 and 27-29, 34-35, dependent on claims 1 and 26, respectively, fall therewith.

In claim 38, applicant has claimed the elastic bumper "non-removably attached" to the plastic housing. It is noted that the term "non-removably attached" in this expression does not find basis or support in the originally filed disclosure of this patent application.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16, 18-29, 32-37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (New Rejection)

It is unclear what is meant by the terminology "fixedly attached" found in each of claims 1 and 26? For example, how much do the two elements have to be attached together to be considered "fixedly attached"?

Claims 2-15, 18-25, 31, 32, 36, 37 and 27-29, 34-35, dependent on claims 1 and 26, respectively, fall therewith.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-16, 18-20, 23, 26-29, 32-35, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishay et al.-US 5,401,591 (Bishay) in view of Faust et al.-US 6,376,126. (Faust) (New Rejection with regard to claim 38)

Reference is made to the Abstract to Bishay along with column 2, line 27 through column 4, line 67 and in particular, column 2, line 63 through column 3, line 55 and column 4, lines 28-51. Also see Figures 1-4 in Bishay. These portions of Bishay teach an elastic bumper boot 106 that is "securably attached" (see column 4, lines 37-38) to the handle of a power tool. The flange portion of 122 is the projection of claim 5. As set forth in the above portions of column 4 in Bishay, the bumper has a durometer rating as applicant has claimed and is formed of an elastomer. The ribs of claim 8 are met by the four corners of the battery housing. The process limitations of claims 9-11 are met by the product in Bishay since the said steps add no patentable to product claims. In view of applicant using the term nominal, claims 12 and 13 are met by the teachings of Bishay because the said thickness of the elastic bumper is approximately the sizes claimed since the thickness of the bumper is known relative to a person's hand on the power tool handle. The battery housing 112 meets the claimed annular elastic member of claim 17. With regard to the vents in the top/floor of the battery cap, reference is made to Figure 3 of Bishay, the top drawing for the plural vents located in the cap portion (a top floor) of the battery housing.

The only claimed features not shown by Bishay are the adhesive bonding of the elastic bumper, the durometer rating of the annular elastic ring, the distance the latch projects from the housing and for the elastic member within the internal cavity. Faust

discloses an elastic member 14 as seen in Figure 4 and in column 5, lines 8-35 and in column 6, line 62 through column 7, line 45 that is located within a battery cavity. To have incorporated the elastic member of Faust in the cavity of Bishay would have been obvious so that the batteries located therein would be provided with significant vibration dampening to preserve the same.

Bonding with an adhesive is a notoriously well known method to attach two members together and to join the elastic bumper to the battery pack in Bishay with an adhesive would have been obvious to provide a very secure fit between the two elements. This is especially obvious because Bishay sets forth the bumper being "securely attached" to the pack as set forth in column 4 therein. The elastic ring having a durometer rating within that claimed would also have been obvious in view of the bumper itself having such a rating that provides for excellent properties. Finally, the claimed distance the latch moves is deemed obvious especially in view of the configuration of the button, latch and bumper thickness as described in the specification and drawings of Bishay and the same would provide for easy removal of the same.

Applicant's arguments have all been considered but are not deemed persuasive. Applicant argues that Bishay and Faust do not teach a fixedly attached elastic bumper. The examiner respectfully disagrees. Because Bishay teaches the bumper therein "securably attached" to the battery pack as column 4, lines 36-39 recites, this teaching meets the claimed recitation of "fixedly attached". It is also noted that the expression "fixedly attached" is very broad terminology.

It is also noted that applicant has not addressed the argument by the examiner set forth above re the obviousness of bonding two members together where the two members comprise the elastic member and the battery pack.

8. Claims 21, 22, 24, 25, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishay and Faust as set forth above and further in view of Pitzen et al.-US 5,553,675. (Pitzen)

The only claimed limitations not taught by Bishay are the tapered guide-way on the cap for receiving a mounting flange on the power tool and for the connectors in the guide-way. Pitzen discloses in the drawings and in column 11, line 31 through column 13, line 55, a tapered guideway for use with attaching a battery pack to a power tool. As set forth in Pitzen, the guideway has variance for receiving a mounting flange on the power tool. It is noted that the guide-ways in Pitzen also include dual connectors as seen in Figure 24 therein. To have included in the Bishay power tool/battery pack, the tapered guideway with connectors as shown in Pitzen would have been obvious for the ease of securement of the battery pack onto the power tool and thus providing power to the power tool via the electrical connectors.

Applicant argues that Pitzen does not teach a fixedly attached elastic bumper. This may be true, however, Pitzen was not applied to the claimed subject matter as teaching this part of the claimed subject matter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-

272-1287. The examiner can normally be reached on Monday-Thursday, 6:15-3:45, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSM/08-04-2006

  
JOHN S. MAPLES  
PRIMARY EXAMINER